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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/074,054 | 02/11/2002 | Siu-Yin Wong | 273102008104 | 9080 |

7590 11/01/2004

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EXAMINER

CHIN, CHRISTOPHER L

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1641

DATE MAILED: 11/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/074,054

Applicant(s)

WONG ET AL.

Examiner

Christopher L. Chin

Art Unit

1641

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 October 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 20 October 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): 112 2nd paragraph rejections.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 26-32Claim(s) withdrawn from consideration: 33-39

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

Christopher L. Chin
Primary Examiner
Art Unit: 1641

DETAILED ACTION

Election/Restrictions

1. Applicants traverse the withdrawal of claims 33-39 because the examiner has not provided a basis for an undue search burden which is required for a restriction requirement.

As noted in the previous office action, new claims 33-39 have a "web of porous material" which was not recited in the claims for which Applicants have already received on examination. A new search would be required to address an immunoassay device with a web of porous material that would not be required for the originally presented claims and thus constitutes an undue search burden.

Claim Rejections - 35 USC § 112

2. Applicant's amendments to claims 29 and 31 overcome the 112 second paragraph rejections of the aforementioned claims.

Claim Rejections - 35 USC § 103

3. In response to the 103 rejections, Applicants argue that a *prima facie* case of obviousness has not been established by the Examiner. Specifically, Applicant point to specific deficiencies in the Tom et al, Svoboda, and Thomas references.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

With respect to the Svoboda reference Applicants argue that the deterioration being precluded by the use of a desiccant is that of the test strip in general, not necessarily of reagents on the strip and not reagents in a device housing.

The test strips in Svoboda contain reagents for detection of hemoglobin (col. 1, lines 5-54). Thus, contrary to Applicant's argument, the deterioration of the test strip being precluded by the use of desiccant would include the reagents on the test strip and not just the test strip. With respect to Applicants phrase "not reagents in a device housing", Applicants are again not considering the combined teachings of the references cited in the 103 obviousness rejection. If Svoboda taught all the limitations recited in the instant claims, it would have been applied as a 102 anticipatory reference.

Applicants further argue that, even if combined, the references do not provide a skilled artisan an expectation of success for the claimed device. Tom et al provides no indication about how its device should be modified to successfully incorporate a desiccant. Applicants submit that the required modification would be considerable to maintain the requisite fluid flow characteristics of the device.

Given the teachings of Thomas, one of ordinary skill in the art would have a reasonable expectation of success in modifying the device of Tom et al to accommodate a desiccant. Thomas shows how a desiccant can be placed in the housing of a test device. Note that the device of Thomas has a separate compartment in the housing that contains the desiccant and thus would not effect the assay

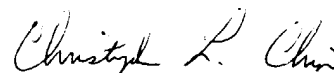
components in the device. Similarly in Tom et al, such a separate compartment with a desiccant would not effect the "requisite fluid flow characteristics of the device".

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher L. Chin whose telephone number is (571) 272-0815. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on (571) 272-0823. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Christopher L. Chin
Primary Examiner
Art Unit 1641

10/31/04

10/31/04